

REMARKS

Reconsideration of the present application is respectfully requested. Claims 1-9 were pending in the application as filed. Claims 5, 7 have been canceled herein, leaving claims 1-4, 6, and 8-9 as the pending original claims. Claims 1 and 6 have been amended in this paper. A separate page identifying the changes effected by the amendments is attached to this paper. New claims 10-18 have been added herein to claim other aspects of the present invention, ones that do not require magnets in the claimed constructions.

Claims 1-4, 6, 8-30 have been rejected under 35 U.S.C. § 103 (a) as unpatentable over U.S. Patent no. 5,737,054 to Chao ("Chao '054") in view of U.S. Patent no. 5,568,207 to Chao ("Chao '207"). Claims 1-4, 6, 8-30 have been rejected under 35 U.S.C. § 103 (a) as unpatentable over Chao '207 in view of Chao '054.

Also, claims 1-9 stand rejected under the judicially created doctrine of obviousness type double patenting, in view of the claims of applicant's U.S. Patent no. 6,109,747 ("Chao '747") issued August 29, 2000. In fact, the present application is a continuation of the application no. 08/847,711, on which Chao '747 issued.

It is respectfully submitted that the rejections of claims 1-4, 6, and 8-30 made under 35 U.S.C. § 103 (a), based on either (1) Chao '054 in view of Chao '207 or (2) Chao '207 in view of Chao '054 are overcome.

To sustain a finding of nonpatentability under section 103, an examiner must show an un rebutted *prima facie* case of obviousness. See *In re Deuel*, 51, F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995).

A *prima facie* case of obviousness requires showing:

- (a) the differences in the claim over the applied references,
- (b) the proposed modification of the applied references necessary to arrive at the claimed subject matter, and
- (c) an explanation why such proposed modification would be obvious. M.P.E.P. § 706.02.

The Examiner maintained that it would have been obvious for one ordinary skill in the art to combine the teachings of Chao '054 in view of Chao '207 (and vice versa). Claim 1 as amended and

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(claim 8) recite an eyeglass combination having features that provide for the engagement of the primary frame and the auxiliary frame at the bridges and sides of the respective frames. Neither of the Chao '207 or the Chao '054 references teach or suggest this combination, and the office action does not provide an explanation of how the skilled artisan would be motivated to combine the teachings of Chao '207 with Chao '054, or vice versa. "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." *Libbey-Owens-Ford v. BOC Group*, 655 F. Supp., 897, 903; 4 USPQ 2d 1097, 1103 (DCNJ 1987) (Emphasis added). While it is permissible to modify a reference's disclosure in the examination of patent applications, such modifications are not allowed if they are prompted by an applicant's disclosure, rather than by a reasoned analysis of the prior art and by suggestions provided therein. *In re Leslie*, 192 USPQ 427 (CCPA 1977).

As the applicant best understands the examiner's position, the motivation to combine the teachings of Chao '054 and Chao '207 comes from the Examiner's position that "In this case, the purpose of providing an auxiliary lens frame which may be easily engaged on the primary lens as disclosed by Chao '054 would have been recognized as an art pertinent art [sic] of Chao '207." As best understood, this rationale fails to provide the requisite motivation to combine. The legal standard requires a finding of motivation to combine. Even if the examiner's statement were accepted as true, pertinence cannot be substituted for motivation to combine. The examiner must still set forth an objective reason to combine the references, or else withdraw the rejection. "A statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill in the art at the time the invention was made, because the references relied upon teach that all aspects to the claimed invention were individually known in the art, is not sufficient to establish a prima facie case obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 18 USPQ 2d 1300 (Bd. Pat. App. & Inter. 1993). Here, the examiner provides no other rationale but that identified above. Accordingly, the rejection is traversed.

Chao '207 teaches an arrangement as shown in the Figure 7 where in magnetic members 22 of arms 21 of auxiliary frame 20 extend over extension 11 of primary spectacle frame 10.

On the other hand, Chao '054 teaches an arrangement as shown in the Figure 4 wherein connector member 24 of middle bridge portion 21 of auxiliary frame 20 extends over middle bridge portion 13 of primary spectacle frame 10. Each reference, with its own distinct teachings as how an auxiliary frame

can be mounted to primary frame, makes no suggestion that the teachings of the references may be combined. Again, when a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. See *In re Geiger*, 815 F. 2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); see also *in re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Since there is no apparent motivation to combine the teachings of Chao '207 with Chao '054 (or vice versa), it is submitted that the present claims are patentable over the prior art of record.

As the applicant best understands the examiner's position, the motivation to combine the teachings of Chao '054 and Chao '207 comes from the Examiner's position that "In this case, the purpose of providing an auxiliary lens frame which may be easily engaged on the primary lens as disclosed by Chao '054 would have been recognized as an art pertinent art [sic] of Chao '207." As best understood, this rationale fails to provide the requisite motivation to combine. The legal standard requires a finding of motivation to combine. Even if the examiner's statement were accepted as true, pertinence cannot be substituted for motivation to combine. The examiner must still set forth an objective reason to combine the references, or else withdraw the rejection. "A statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill in the art at the time the invention was made, because the references relied upon teach that all aspects to the claimed invention were individually known in the art, is not sufficient to establish a prima facie case obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 18 USPQ 2d 1300 (Bd. Pat. App. & Inter. 1993). Here, the examiner provides no other rationale but that identified above. Accordingly, the rejection is traversed.

Wherefore, based upon the foregoing it is submitted that the application is in condition of allowance and a relatively early reply to this paper would be appreciated.

Respectfully submitted,



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